

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Patent Application of:  
Johannes Antonius Maria Hamersma *et al.*

Application No.: 10/594,103

Conf. No.: 7265

Filed: September 25, 2006

Art Unit: 1612

For: PROGESTERONE RECEPTOR  
MODULATORS

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Examiner: Barbara P. Badio

**REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT  
DETERMINATION UNDER 37 CFR §1.705(B)**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the Notice of Allowability issued September 25, 2009, Applicants respectfully request reconsideration of the Patent Term Adjustment of 339 days noted on page 3 of the Notice, and request that it be corrected to 532 days. The present request, being filed along with the issue fee transmittal, is timely. 37 C.F.R. §1.705(b).

The office is authorized to charge deposit account no. 50-4205 the required fees set forth in 37 C.F.R. §1.18(e) (\$200) and 37 C.F.R. §1.705(b)(1).

Applicants respectfully submit that the correct Patent Term Adjustment is 532 days. The basis upon which Applicants request reconsideration of the patent term adjustment is as follows (for details see attached AIPA Term Calculation Report utilizing Professor Kayton's patent Term® on line program):

1. Under the 14-Month Rule [(§1.703(a))] the present application was filed on September 25, 2006 and the First Action was mailed January 26, 2009. Accordingly under the 14-Month rule the period of adjustment for the USPTO delay is 428 days which is also reflected in the Patent Term Adjustment History.

2. Under the 3-Month Rule [(§1.704(b))], a period of adjustment of 89 days of Applicant delay has been calculated from the Non-Final Action mailed January 26, 2009 to the date of Reply to this Action, July 24, 2009, as is also reflected in the Patent Term Adjustment History.

3. However, should a patent issue after September 25, 2009 (three years from the September 25, 2006 date that the National Stage commenced under 35 U.S.C. 371(b)) adjustment of the patent term pursuant to 35 U.S.C. §154(b) would be implicated based upon the Wyeth et al. v. Dudas ruling recently published (No. 07-1492 D.D.C. September 30, 2008). Assuming an estimated issue date of April 6, 2010, it is respectfully submitted that the period of adjustment for USPTO delay (in accordance with the ruling in Wyeth et al. v. Dudas) begin on the day after the three year period, September 25, 2009 (see attached AIPA Term Calculation Report utilizing Professor Kayton's patent Term® on line program) and end on the aforementioned estimated issue date, which is a period of adjustment due to USPTO delay of 193 days.

4. Accordingly, Applicants respectfully submit that the patent term adjustment period is the total days debited the USPTO, 621 days, minus the total number of days debited Applicants, 89 days, to yield a total patent term adjustment of 532 days (see attached AIPA Term Calculation Report utilizing Professor Kayton's patent Term® on line program).

The present application is not subject to a terminal disclaimer [37 C.F.R. §1.705(b)(2)(iii)].

Applicants reserve the right, under 37 C.F.R. §1.705(d), to request further revisions to the patent term adjustment, should the Office fail to note the revised patent term adjustment on the

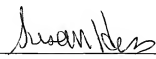
face of any patent issuing from the present application, or fail to timely issue any patent issuing from the present application.

Early and favorable action is earnestly solicited.

Dated: December 16, 2009

Respectfully submitted,

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Attachment

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## AIPA Term Calculation Report

APPLICATION INFORMATION			
Docket Number:	2004.833US	User Name:	Hess, Susan
Application Number:	10/594,103	Firm/Company Name:	Organo, a part of Schering-Plough
Filing Date:	03/18/2005	User Comments:	
Title/Inventor(s):	PROGESTERONE RECEPTOR MODULATORS; Johannes Antonius Maria Hamersma, Oss, (NL)		
		Calculation Generated:	12/08/2009 06:24:38 PM ET

AIPA TERM CALCULATION SUMMARY			
Earliest Referenced Application under 35 USC § 120, 121, or 365(c):		03 / 18 / 2005	
International Filing Date:		03 / 18 / 2005	
Net Adjustment Credits:		621 Days	
Net Adjustment Debits:		89 Days	
Patent Term Adjustment:		532 Days	
AIPA Patent Term End Date:		09 / 01 / 2026 (1)	
(1) Assumes payment of all maintenance fees, no intervening acts, and no 35 USC § 156 regulatory extensions. Terminal disclaimer(s) filed in this case, if any, may result in an earlier term end date. Without adjustment, the term would end on 03/18/2025.			

COMPARISON TO USPTO PAIR PTA TAB (2)			
(Based on PAIR Date from 12/08/2009)			
	PAIR PTA Tab	Your Calculation	Comparison
Credit Days (USPTO Delay):	428	621	X
Debit Days (Applicant Delay):	89	89	Match
Total Patent Term Adjustment Days:	339	532	X
(2) Comparison is shown for USPTO Delay, Applicant Delay, and Total Patent Term Adjustment fields displayed on USPTO PAIR Patent Term Adjustments (PTA) tab on 12/08/2009. See the full PAIR PTA tab file wrapper (e.g., Notice of Allowance, PTA-related petitions), and issued patent for complete information on USPTO-calculated PTA.			

REFUGAL CITATION SUMMARY (A)

Event	Rule Invoked	Related Event	Exclusion Days (A)	Debit Days (S)	Credit Days (G)
A National Stage Commenced under 35 USC 371(b) or (f)	<p><b>3-Year PTO Issue of Patent</b></p> <p>PTO must issue a patent within 3 years (not including exclusions) after the date on which the application was filed under 35 USC 111(a) or the national stage commenced under 35 USC 371(b) or (f) in an international application. Period of adjustment (credits) begins on the day after the date that is 3 years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 USC 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the sum of the listed exclusionary periods. 35 USC 154(b)(1)(B); 37 CFR 1.702(b), 1.703(b).</p> <p>You have elected to analyze this rule without applying the USPTO 37 CFR § 1.703(f) Actual Delay limitation in determining Credit Days under this rule. This is consistent with DC District Court ruling in <i>Wyeth et al. v. Dudas</i>, No. 07-1492 (D.D.C. September 30, 2008).</p>	Issue Date: 04/06/2010 Issue Date			193
B Application Fulfilled Requirements of 35 USC 371	<p><b>14-Month PTO First Action</b></p> <p>PTO must mail a notification under 35 USC 132 or a notice of allowance under 35 USC 131 not later than 14 months after the date on which the application was filed under 35 USC 111(a) or fulfilled the requirements of 35 USC 371 in an international application. Period of adjustment (credits) begins on the day after the date that is 14 months after the date on which the application was filed under 35 USC 111(a) or fulfilled the requirements of 35 USC 371 and ending on the date of mailing of either an action under 35 USC 132, or a notice of allowance under 35 USC 131, whichever occurs first. 35 USC 154(b)(1)(A)(i); 37 CFR 1.702(a)(1), 1.703(a)(1).</p>	First PTO Action: 01/26/2009 Non-Final Action			428
C Non-Final Action 01/26/2009	<p><b>3-Month Applicant Response to Notice or Action</b></p> <p>Period of adjustment (credits) shall be reduced for the period in excess of 3 months taken to reply to any PTO notice or action making any rejection, objection, argument, or other request, beginning on the day after the date that is 3 months after the date of mailing or transmission of the Office communication and ending on the date the reply was filed. The period, or shortened statutory period, for reply set in the action or notice has no effect on this deadline. 35 USC 154 (b)(2)(C)(i); 37 CFR 1.704(b).</p> <p>Where applicant shows, in spite of all due care, applicant was unable to respond within the 3-month period, all or part of adjustment may be reinstated for up to 3 additional months. 35 USC 154(b)(3)(C); 37 CFR 1.705(c).</p> <p>You have indicated that no 1.705(c) Showing of Due Care was made.</p>	Applicant Response: 07/24/2009 Reply after Non-Final Action under 37 CFR 1.111		89	

D	07/24/2009 Reply after Non-Final Action under 37 CFR 1.111	PTO Response: 09/25/2009 Notice of Allowance under 35 USC 151		0
E	09/25/2009 Notice of Allowance under 35 USC 151	Applicant Response: 12/25/2009 Issue Fee Payment under 35 USC 151	0	
F	12/25/2009 Issue Fee Payment under 35 USC 151	Issue Date: 04/06/2010 Issue Date		0
Total Exclusion, Debit, and Credit Days:				
Overlap Days (7) :			0	621
Net Exclusion, Debit, and Credit Days:			0	0
Patent Term Adjustment Days (8) :			0	621

#### 4-Month PTO Response to Applicant Reply

PTO must respond to a reply under 35 USC 132 not later than 4 months after the date on which the reply was filed. The period of adjustment (credits) begins on the day after the date that is 4 months after the date a reply under 37 CFR 1.111 or in compliance with 37 CFR 1.113(c) was filed and ending on the mailing date of either an action under 35 USC 132, or a notice of allowance under 35 USC 151, whichever occurs first. 35 USC 154(b)(3)(A)(i); 37 CFR 1.702(a)(2), 1.703(a)(2)(3).

#### 3-Month Applicant Response to Notice of Action

Period of adjustment (credits) shall be reduced for the period, in excess of 3 months taken to reply to any PTO notice of action making any rejection, objection, argument, or other request, beginning on the day after the date that is 3 months after the date of mailing or transmission of the Office communication and ending on the date the reply was filed. The period, or shortened statutory period, for reply set in the action or notice has no effect on this deadline. 35 USC 154 (b)(2)(C)(i); 37 CFR 1.704(b).

Where applicant shows, in spite of all due care, applicant was unable to respond within the 3-month period, all or part of adjustment may be reinstated for up to 3 additional months. 35 USC 154(b)(3)(C); 37 CFR 1.705(c).

You have indicated that no 1.705(c) Showing of Due Care was made.

#### 4-Month PTO Issue of Patent

PTO must issue a patent not later than 4 months after the date on which the issue fee was paid under 35 USC 151 and all outstanding requirements were satisfied. The period of adjustment (credits) begins on the day after the date that is 4 months after the date the issue fee was paid and all outstanding requirements were satisfied and ends on the day the patent issues. 35 USC 154(b)(1)(A)(iv); 37 CFR 1.702(a)(4), 1.703(a)(6).

- (3) Calculations of Debit, Credit, and Exclusion Days are determined by the rule assignments, assignments of related events, and analysis options in the Apply Term Rules tab. The patent professional using this system is responsible for reviewing and updating the Apply Term Rules tab to ensure all data is complete, correct, and consistent with their judgment and interpretation of applicable legal authority.
- (4) Exclusion Days are periods which are not included in determining the end of the 3-year period after the date on which the application was filed under 35 USC 111(a), or the national stage commenced under 35 USC 371(b) or (f) in an international application, used to determine credits under the 3-Year PTO Issue of Patent rule. See 35 USC 1340(b) (WBAD-due: 37 CFR 1.702(b)(1)(5); 1.703(b)(1) (4).
- (5) Debit Days are days where grounds for reduction of adjustment of patent term exist. See, e.g., 37 CFR 1.704. Debit Days are sometimes referred to as Applicant Delay.
- (6) Credit Days are days where grounds for adjustment of patent term exist. See, e.g., 37 CFR 1.702, 1.703. Credit Days are sometimes referred to as USPTO Delay.
- (7) To the extent credit periods overlap other credit periods, debit periods overlap other debit periods, or exclusion periods overlap other exclusion periods, overlaps are subtracted so that each calendar day generates at most one credit day, one debit day, and one exclusion day.
- (8) Patent Term Adjustment Days equals Net Credit Days minus Net Debit Days, but is not less than zero.